

Amendment  
US Serial No. 09/866,960  
Filed: May 29, 2001  
Scancarella et al.

### REMARKS

Claims 1-21 and 23-87 are pending in the application. The Examiner has withdrawn the rejection of Claims 1-21 and 23-85 and 87 under 35 U.S.C. §112 from the prior Office Action. Claims 1-21 and 23-87 are rejected under 35 U.S.C. §103(a).

Applicants first note that the claims have been amended to specify a composition that contains two film forming polymers; one of which is a silicone/acrylate or vinyl/silicone copolymer and the other a silicone resin. Support for this change is found beginning on page 13, line 15 through page 20, line 12 for the silicone/acrylate copolymer and vinyl/silicone copolymers, and beginning on page 24, line 30 through page 27, line 6 for the silicone resin.

### The Rejection Under 35 U.S.C. §103

Claims 1-21 and 23-87 remain rejected under 35 U.S.C. §103(a) as unpatentable over Shaw (WO 00/47168) and McDermott (U.S. Patent No. 6,248,336) in further view of Calello (U.S. Patent No. 5,849,275). The Examiner maintains the rejection previously advanced, contending that Applicants' prior arguments were not found convincing.

The Examiner states:

*Applicant argues that none of the references relied upon in rejecting the pending claims disclose a cosmetic composition which includes the ingredients required by the presently mended claims where the composition has a viscosity of about 1,000 to 500,000 centipoise at 25 degrees Celsius and where the organic pigment is the main color component of the composition and is present in an amount of 0.1-95%. Applicant also argues that none of the cited references teach how the film forming polymers required for the claimed compositions are combined with organic pigments in order to provide a cosmetic composition having a viscosity of 1,000 to 500,000 centipoise at 25 degrees Celsius, as claimed.*

Nonetheless, the Examiner concludes that:

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*...it is well within the skill of those having ordinary skill in the art, to adjust the viscosity of an emulsion to arrive at a desired viscosity.*

The Examiner further provides a copy of Cosmetics, Science and Technology, Emulsification, Chapter 42, (1966) by William C. Griffin, alleging that it is a *teaching reference to demonstrate that those skilled in the art clearly recognize the viscosity of an emulsion as a property of an emulsion which can be easily controlled*, and refers to pages 998-1004.

Applicants note that they have cancelled the viscosity limitation from all the claims, thus making moot the Examiner's rejection on this ground. The amended claims are now directed to a composition that contains a silicone resin in combination with a silicone/acrylate or vinyl/silicone copolymer in combination with the organic pigments, and water and oil.

None of the references cited by the Examiner; McDermott (U.S. Patent No. 6,248,336), Calello (U.S. Patent No. 5,849,275) or Shah (WO 00/47168) teach or suggest the use of the composition now defined by the amended claims. In particular, none of these references teach or suggest compositions containing silicone resins or the combination of silicone resins and silicone/acrylate copolymers or silicone resins and vinyl/silicone copolymers.

Shaw teaches compositions containing polymers comprised of ethylenically unsaturated monomers. Calello teaches compositions containing various types of silicone acrylate copolymers. McDermott teaches emulsion compositions containing various types of silicone/acrylate copolymers or copolymers from ethylenically unsaturated

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monomers. None of the references teach or suggest a composition containing both silicone/acrylate copolymers and silicone resins.

Claim 1, as currently amended, is directed to a cosmetic composition which is in the form of a water and oil emulsion which is comprised of a water phase, an oil phase, at least one silicone/acrylate or vinyl/silicone film forming polymer and at least one silicone resin, at least one organic pigment which is present in an amount of at least about 0.1-95% by weight of the composition and must be the main color component of the composition. The claim also provides that there is no inorganic pigment and that the water is present in an amount of about 0.1-95% and that the oil is present in an amount of 0.1-99.9%. Claim 30 claims a similar cosmetic composition but provides that both an organic pigment and an inorganic pigment are dispersed in the oil phase of the cosmetic composition. Claim 48, also, claims a similar cosmetic composition compared to claims 1 and 30, but further stipulates that the organic pigment is solubilized in the water phase while at least one inorganic pigment is dispersed in the oil phase. Claim 66 is directed to a similar cosmetic composition but stipulates that the at least one organic pigment is dispersed in the oil phase, while at least one inorganic pigment is solubilized in the water phase. Claim 81 is directed to a cosmetic composition of the type claimed in claims 1, 30, 48, and 66, but stipulates that both the organic pigment(s) and inorganic pigment(s) are solubilized in the water phase. Claim 86 is directed to similar compositions wherein said compositions do not contain any synthetic or natural waxes. All of the independent claims require that the at least one organic pigment is present in an amount of about 0.1-95% by the weight of the composition and that, where the inorganic pigment is present, it

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is present in an amount of 0.001-15% by weight of the composition, but in all cases the organic pigment forms the main color component of the composition.

Initially, applicants would note that none of the references relied upon in rejecting the pending claims in this application disclose a cosmetic composition having two film forming polymers – a silicone resin and a silicone/acrylate or vinyl/silicone copolymer, and where the organic pigment is the main color component of the composition and is present in an amount of 0.1-95% as now required by the claims. Further, as the Examiner has acknowledged Shaw does not describe or suggest an oil and water emulsion, the copolymer of instant claims 18-20, 38-40, 55-57, and 73-75, (3) the surface coating pigments as claimed in claims 33 and 50 and (4) the pigments comprised in specific phases as required by claims 3-4 and 30-85.

A conclusion of obviousness premised on a combination of references must identify a reason, suggestion, or motivation which would have led an inventor to combine those references. Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 U.S.P.Q. 2d 1626, 1629, (Fed. Cir. 1996)

It is insufficient that the prior art discloses the components of the claimed invention, either separately or in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by appellants. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) (insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor).

Here there is no evidence or teaching which would have reasonably suggested or directed one of ordinary skill to combine the teachings of these diverse references in a

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manner which would reasonable lead to or result in the specific combination of ingredients in the specific form and amounts required by the pending claims. Absent some teaching of this nature demonstrated to be present in the prior art, the combination of references presently relied on by the Examiner fails to provide that evidence which would make the claimed subject matter obvious within the meaning of 35 U.S.C. §103.

As set forth in In re Kotzab, 217 F.3d 1365, 1369-70, 55 U.S.P.Q. 2d 1313, 1316 (Fed. Cir. 2000):

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher. . .

Most if not all inventions arise from a combination of old elements. . . . Thus, every element of a claimed invention may often be found in the prior art. . . . However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. . . . Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. [citations omitted]

In other words, in the present application, the prior art relied on by the Examiner can be reasonably read only to demonstrate that some of the ingredients of the presently claimed cosmetic composition are old for use in cosmetic composition. However, the references, whether viewed individually or taken in combination, do not provide any suggestion or direction which can be said to direct one of ordinary skill in this art to combine these ingredients in a manner to arrive at the specific claimed composition of the pending claims. Further even if the references did provide such suggestion, none of the

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references cited specifically teach that silicone resins, even less suggest that such resins should be combined with silicone/acrylate or vinyl/silicone copolymers to arrive at the claimed compositions.

As stated in Echolochem, Inc. v. Southern California Edison, 227 F.3d 1361, 1375, 56 U.S.P.Q. 2d 1065, 1075-76 (Fed. Cir. 2000) "There still must be evidence that a skilled artisan, . . . with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." Here, there is no such evidence. Thus, this rejection reasonably appears to be based on the use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Even with the use of hindsight, no reconstruction would be possible to arrive at the claimed compositions using the references cited by the Examiner for none of the references cited teach silicone resins.

Further, it is Applicants' position that the claimed compositions would not be obvious. For, silicone/acrylate or vinyl/silicone polymers are already known to be film formers as taught by the references. Thus, it is not for the lack of this quality that one skilled in the art would be lead to add yet another film forming polymer, specifically a silicone resin, in the compositions having the other specific claimed ingredients.

#### **Conclusion:**

The Examiner is respectfully requested to reconsider the patentability of all claims pending in the application in view of the amended claims. The invention is now directed to a specific cosmetic composition comprising a combination of film forming polymers, which are at least a silicone/acrylate or vinyl/silicone copolymer, a silicone resin, and organic pigments in a water and oil emulsion as described.

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None of the references cited – Shah, Calello, McDermott, nor Cosmetics Science and Technology, teach or suggest a composition as described by the amended claims.

The Examiner is respectfully requested to reconsider the rejection of the claims under 35 U.S.C. §103(a).

Respectfully Submitted,



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